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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,715	01/21/2004	Mark E. Cook	960296.00143	3715

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EXAMINER	
SZPERKA, MICHAEL EDWARD	
ART UNIT	PAPER NUMBER
1644	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/761,715	COOK ET AL.	
	Examiner	Art Unit	
	Michael Szperka	1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) *11 and 23* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10, 12-22, and 24-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/29/04, 4/25/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's response and amendments received October 27, 2006 are acknowledged.

Claims 25 and 26 have been added.

Claims 1-26 are pending in the instant application.

Applicant's election of the species of chickens as a target group of animals and orally as an administration route in the reply filed on October 27, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Specifically applicant did not indicate if the election was made with or without traverse and did not present arguments as to the propriety of the species election requirement.

Claims 11 and 23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 27, 2006. Note that in view of the teachings of the art, the species election concerning the route of administration has been withdrawn and the search of target animals has been extended to encompass turkey, ducks, geese, quail, bovine, ovine, porcine, and caprine animals as well as the elected species of chickens.

Claims 1-10, 12-22 and 24-26 are under examination as they read on methods of administering agents that improve body weight uniformity and carcass yield.

Information Disclosure Statement

2. Applicant's IDS forms received 4/29/04 and 4/25/05 are acknowledged and have been considered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-3, 5-10, 13-15, 17-22, 25, and 26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for administering anti-PLA_2 antibodies, does not reasonably provide enablement for administering the genus of all agents that reduce the bioavailability of a prostaglandin or leukotriene lipid precursor such that body weight uniformity or carcass yield are increased. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicant has claimed broad methods for increasing body weight uniformity and carcass yield in animals. These methods differ only in their intended goal as recited in the preamble, since the recited process steps comprise administering the same agent to the same target population. The administered "agent" is recited as being one that reduces the bioavailability of a prostaglandin or leukotriene lipid precursor. Working examples disclosed in the specification comprise antibodies that bind and inhibit the enzymatic activity of phospholipase A_2 (PLA_2).

PLA_2 is important for the generation of arachidonate from phospholipids, with arachidonate then being used in the production of leukotrienes and prostaglandin hormones (Stryer, L., see particularly figure 24-24). Large numbers of structurally unrelated PLA_2 inhibitors are known in the art and are generically taught for use in the treatment of inflammation and inflammatory disorders (see US Patents 5,086,067, 5,112,864, 5,218,124, WO 91/06537, and WO 95/33715). However, the claims are not limited to administering PLA_2 inhibitors. Horrobin et al. teach that in addition to being released directly from phospholipids, arachidonate is made in vivo from smaller lipid precursors via multi-step enzymatic processes (US Patent 5,178,873, see entire

document, particularly Table 1). As such, it would appear that there are a vast number of steps that can be regulated to control the production and/or release or arachidonate in animals. Further, applicant's claims are not limited to arachidonate but are directed to any prostaglandin or leukotriene lipid precursor. Large numbers of structurally distinct prostaglandins and leukotrienes are known, with each comprising its own set of precursors (Granstrom et al, see entire document, particularly Figures 2 and 3), any of which can be targeted by an "agent" in applicant's claimed methods. As such, the breadth of the claims read on the use of unspecified "agents" that inhibit unspecified enzymes and precursor molecules.

As stated previously, the specification provides a working example wherein antibodies that bind and inhibit the enzymatic activity of PLA_2 are administered to chickens (see particularly paragraph 22 and Examples 1 and 2). No other working examples comprising the use of either a different "agent", such as a small organic molecule, or the "targeting" of an enzyme or pathway component other than PLA_2 are disclosed. The specification discloses that while it is not clear why administering anti-PLA_2 antibodies achieves the recited goals of increasing weight uniformity and carcass yield, it is believed that by limiting arachidonate less prostaglandins and leukotrienes are produced that will cause gastrointestinal inflammation and thus negatively impact digestion and nutritional absorption (see particularly paragraphs 20 and 21). Note that the specification does not disclose the identity of one or more specific prostaglandins or leukotrienes that are thought to be responsible for gastrointestinal inflammation.

Given the large number of possible "agents" that target all the numerous components involved in prostaglandin and leukotriene synthesis, the lack of a disclosure as to which prostaglandins, leukotrienes, or their lipid precursors are important for mediating gastrointestinal inflammation and malabsorption, and the working examples wherein only a single "agent" consisting of anti-PLA_2 antibodies was administered to achieve the recited goals, it does not appear reasonable that a skilled artisan could make any "agent" and then administer said "agent" to an animal to obtain increased weight uniformity and carcass yield without first conducting additional unpredictable research.

5. Claims 1-3, 5-10, 13-15, 17-22, 25, and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicant has claimed methods wherein an "agent" is administered to an animal to increase body weight uniformity and carcass yield. The "agent" is recited as being capable of reducing the bioavailability of a prostaglandin or leukotriene lipid precursor. To support this broad genus of "agents" applicant has disclosed antibodies that bind and inhibit the enzymatic activity of PLA_2.

The guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, § 1 "Written Description" Requirement make clear that if a claimed genus does not show actual reduction to practice for a representative number of species, then the Requirement may be alternatively met by reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the genus (Federal Register, Vol. 66, No. 4, pages 1099-1111, Fri. January 5, 2001, see especially page 1106 column 3).

PLA_2 is known to cleave phospholipids resulting in the release of arachidonate, but the breadth of the claims encompass more than specifically inhibiting PLA_2 activity. Numerous structurally distinct prostaglandins and leukotrienes are known, and their synthesis can be inhibited at numerous points as they are assembled from precursor molecules (see particularly Granstrom et al., Table 1 of US Patent 5,178,873, and Stryer, L.). Many PLA_2 inhibitors are known in the prior art, and there do not appear to be any structural or physical similarities that can be used to define this genus of reagents (see US Patents 5,086,067, 5,112,864, 5,218,124, 6,213,930, 6,383,485, WO 91/06537, and WO 95/33715). Given that there does not appear to be a specific structure associated with the function of inhibiting PLA_2, there does not appear to be

any correlation between structure and function for the larger genus of all agents that "reduce the bioavailability of a prostaglandin or leukotriene lipid precursor". Given these structural differences, the species of antibodies that inhibit PLA_2 are not reasonable representatives of the recited genus of "agents." Note that excepting claims 4, 12, 16, and 24, no structure is recited concerning the administered "agent".

In University of California v. Eli Lilly and Co. (CAFC) 43 USPQ2d 1398, the court stated: "A definition by function, as we have previously indicated, does not suffice to define the genus because it is only an indication of what the gene (in the instant case, an agents) does, rather than what it is. See Fiers, 984 F.2d at 1169-71, 25 USPQ2d at 1605-06 (discussing Amgen). It is only a definition of a useful result rather than a definition of what achieves that result. Many such genes (agents) may achieve that result. The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See In re Wilder, 736 F.2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outlin [e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate."). Accordingly, naming a type of material generally known to exist, in the absence of knowledge as to what that material consists of, is not a description of that material."

The court has also noted that "Adequate written description requires a precise definition, such as by structure, formula, chemical name or physical properties, not a mere wish or plan for obtaining the claimed chemical invention." Id. at 1566, 43 USPQ2d at 1404 (quoting Fiers, 984 F.2d at 1171, 25 USPQ2d at 1606). Also see Enzo-Biochem v. Gen-Probe 01-1230 (CAFC 2002).

As discussed above, the instant claims do not recite any structure concerning the administered "agent" excepting claims limited to administering anti-PLA_2 antibodies, and it does not appear that there is any disclosed correlation between structure and the function of "reducing bioavailability of a prostaglandin or leukotriene lipid precursor".

Therefore, it appears that the broad genus of "agents" recited in the claimed methods lack adequate written description because of the lack of recited structural

elements, the lack of a correlation between structure and function, and the non-representativeness of anti-PLA_2 antibodies as members of the recited genus of "agents". As such a skilled artisan would reasonably conclude that applicant was not in possession of the recited genus of "agents that can reduce the bioavailability of a prostaglandin or leukotriene lipid precursor" at the time the application was filed.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-10, 12-22 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 6,213,930 (of record on the 4/29/04 IDS, see entire document).

The '930 patent teaches methods of administering anti-phospholipase A_2 (anti-PLA_2) antibodies to animals to enhance animal growth and feed efficiency. This patent teaches that PLA_2 cleaves the covalent bond between arachadonic acid and membrane phospholipids, thus releasing arachadonic acid to serve as a prostaglandin/leukotriene precursor (see particularly lines 44-50 of column 1). Note that anti-PLA_2 antibodies are disclosed as inhibiting the activity of PLA_2 which thus effectively limit the bioavailability of arachidonic acid (see particularly lines 25-51 of column 2). Animals to be administered anti-PLA_2 antibodies comprise chickens, ducks, turkeys, quail, geese, cows, sheep, pigs, and goats (see particularly lines 8-13 of column 3). The anti-PLA_2 antibodies are administered by a variety of routes, comprising subcutaneously, intraperitoneal, intramuscular, intravenous, and oral, with the oral route being preferred (see particularly lines 52-62 of column 3). The '930 patent further teaches that anti-PLA_2 antibodies can be obtained from the yolk of immunized chickens, and that egg preparations comprising the specific antibody are to be given as a supplement to the animal's diet (see particularly from line 63 of column 3 to line 22 of column 4).

It is noted that the preamble of the instant claims recite "improving body weight uniformity" and "increasing carcass yield" and that these particular phrases are not found within the text of the '930 patent. However, the process steps of the instant claims comprise administering an agent, such as an anti-PLA_2 antibody, to an animal. These process steps are taught by the '930 patent as discussed above. As such it appears that improved body weight uniformity and increased carcass yield are inherent benefits that accrue to an animal upon performance of the methods of administering anti-PLA_2 antibodies disclosed in the '930 patent. Applicant is reminded "[T]he discovery of a previously unappreciated property of a prior art composition (method), or of a scientific explanation for the prior art's functioning, does not render the old composition (method) patentably new to the discoverer." Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Further, there is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. Schering Corp. v. Geneva Pharm. Inc., 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003) (rejecting the contention that inherent anticipation requires recognition by a person of ordinary skill in the art before the critical date and allowing expert testimony with respect to post-critical date clinical trials to show inherency); see also Toro Co. v. Deere & Co., 355 F.3d 1313, 1320, 69 USPQ2d 1584, 1590 (Fed. Cir. 2004)("[T]he fact that a characteristic is a necessary feature or result of a prior-art embodiment (that is itself sufficiently described and enabled) is enough for inherent anticipation, even if that fact was unknown at the time of the prior invention.").

Given that the same agent is administered to the same patient population, the methods of the '930 patent anticipate the claimed invention.

8. Claims 1-10, 12-22 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 6,383,485, (see entire document).

The '485 patent teaches methods of administering anti-phospholipase A_2 (anti-PLA_2) antibodies to animals to enhance animal growth and feed efficiency. This patent teaches that PLA_2 cleaves the covalent bond between arachadonic acid and membrane phospholipids, thus releasing arachadonic acid to serve as a prostaglandin/leukotriene precursor (see particularly lines 46-51 of column 1). Note that anti-PLA_2 antibodies are disclosed as inhibiting the activity of PLA_2 which thus effectively limit the bioavailability of arachidonic acid (see particularly lines 26-53 of column 2). Animals to be administered anti-PLA_2 antibodies comprise chickens, ducks, turkeys, quail, geese, cows, sheep, pigs, and goats (see particularly lines 10-15 of column 3). The anti-PLA_2 antibodies are administered by a variety of routes, comprising subcutaneously, intraperitoneal, intramuscular, intravenous, and oral, with the oral route being preferred (see particularly lines 52-63 of column 3). The '485 patent further teaches that anti-PLA_2 antibodies can be obtained from the yolk of immunized chickens, and that egg preparations comprising the specific antibody are to be given as a supplement to the animal's diet (see particularly from line 64 of column 3 to line 22 of column 4).

It is noted that the preamble of the instant claims recite "improving body weight uniformity" and "increasing carcass yield" and that these particular phrases are not found within the text of the '485 patent. However, the process steps of the instant claims comprise administering an agent, such as an anti-PLA_2 antibody, to an animal. These process steps are taught by the '485 patent as discussed above. As such it appears that improved body weight uniformity and increased carcass yield are inherent benefits that accrue to an animal upon performance of the methods of administering anti-PLA_2 antibodies disclosed in the '485 patent. Applicant is reminded "[T]he discovery of a previously unappreciated property of a prior art composition (method), or of a scientific explanation for the prior art's functioning, does not render the old composition (method) patentably new to the discoverer." Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Further, there is no requirement that a person of

ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. Schering Corp. v. Geneva Pharm. Inc., 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003) (rejecting the contention that inherent anticipation requires recognition by a person of ordinary skill in the art before the critical date and allowing expert testimony with respect to post-critical date clinical trials to show inherency); see also Toro Co. v. Deere & Co., 355 F.3d 1313, 1320, 69 USPQ2d 1584, 1590 (Fed. Cir. 2004)("[T]he fact that a characteristic is a necessary feature or result of a prior-art embodiment (that is itself sufficiently described and enabled) is enough for inherent anticipation, even if that fact was unknown at the time of the prior invention.").

Given that the same agent is administered to the same patient population, the methods of the '485 patent anticipate the claimed invention.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In *re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-10, 12-22 and 24-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,213,930. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims anticipate the instant invention.

Specifically, patented claim 1 recites "administering to said animal an agent that reduces the bioavailability in the animal of a prostaglandin or leukotrienes lipid precursor, wherein the agent comprises an antibody". The independent claims in the instant application are not limited to administering antibodies, and as such the patented method claims anticipate the instant invention. Note that dependent patented claims recite anti-PLA_2 antibodies, that mammals such as cows and avians such as chickens are subjects for antibody administration, and that the antibodies can be administered by various injection routes or orally mixed with food, such as an egg preparation that comprises antibodies.

It is noted that the patented claims recite that the antibodies are administered to "enhance growth and feeding behavior" while the instant methods are recited as "improving body weight uniformity" and "increasing carcass yield". However, as discussed above, the antibodies administered in the patented claims anticipate the instant recited genus of administered agents and the populations to whom the agents are administered are not distinctly different. Therefore, "improved body weight" and "increased carcass yield" are inherent properties that arise when the patented method is performed in an animal.

Applicant is reminded "[T]he discovery of a previously unappreciated property of a prior art composition (method), or of a scientific explanation for the prior art's functioning, does not render the old composition (method) patentably new to the discoverer." Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

11. Claims 1-10, 12-22 and 24-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,383,485. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims anticipate the instant invention.

Specifically, patented claim 1 recites "administering to said animal an agent that reduces the bioavailability in the animal of a prostaglandin or leukotrienes lipid precursor, wherein the agent comprises an antibody". The independent claims in the instant application are not limited to administering antibodies, and as such the patented method claims anticipate the instant invention. Note that dependent patented claims recite anti-PLA_2 antibodies, that mammals such as cows and avians such as chickens are subjects for antibody administration, and that the antibodies can be administered by various injection routes or orally mixed with food, such as an egg preparation that comprises antibodies.

It is noted that the patented claims recite that the antibodies are administered to "reduce gastrointestinal inflammation" while the instant methods are recited as "improving body weight uniformity" and "increasing carcass yield". However, as discussed above, the antibodies administered in the patented claims anticipate the instant recited genus of administered agents and the populations to whom the agents are administered are not distinctly different. Therefore, "improved body weight" and "increased carcass yield" are inherent properties that arise when the patented method is performed in an animal.

Applicant is reminded "[T]he discovery of a previously unappreciated property of a prior art composition (method), or of a scientific explanation for the prior art's functioning, does not render the old composition (method) patentably new to the discoverer." Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

12. No claims are allowable.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Szperka whose telephone number is 571-272-2934. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Szperka, Ph.D.
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Technology Center 1600
January 17, 2007

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